



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/046,083 | 01/16/2002 | Charles M. Fish | GEN-118 | 2441 |

23353 7590 03/23/2006

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/046,083 | Applicant(s) FISH ET AL. | |
| | Examiner Mary Cheung | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on January 5, 2006. Claims 48-51 are newly added and are currently pending. Claims 1-47 are canceled.

Response to Arguments

2. Applicant's arguments with respect to claims 48-51 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551.

As to claim 48, Barlow teaches a system for rendering content comprising
(column 12 lines 11-14):

- a) A set-top terminal that has at least one port (Fig. 1 and column 7 line 64 – column 8 line 6);
- b) A security separable module that include a physical layer key wherein the security separable module is removably coupled to the set-top terminal via the at least one port and the physical layer key allows rendering of the content (column 7 line 64 – column 8 line 9 and column 18 lines 20-33 and Figs. 1, 3).

Art Unit: 3621

Barlow does not specifically teach the rendered content is video content. It would have been obvious to one of ordinary skill in the art to allow the rendered content in Barlow's teaching to be video content for expanding the usage environment and better promoting utilization of Barlow's system.

5. Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlow et al., U. S. Patent 6,038,551 in view of Solomon, US 2003/0070174 A1.

As to claim 49, the modified teaching of Barlow further discloses plurality of keys stored in the security separable module that allows rendering of the video content (column 12 lines 15-23 and column 18 lines 20-33 and Fig. 3). Barlow does not specifically teach an activation key stored in the security separable module that allows rendering of the video content (column 12 lines 15-23 and column 18 lines 20-33 and Fig. 3). However, Solomon teaches an activation key that allows rendering of the video content (Fig. 4). It would have been obvious one of ordinary skill in the art at the time the invention was made to allow the module in Barlow's teaching to include an activation key that allows rendering of the video content for preventing authorized access of the content.

As to claim 50, Barlow teaches using physical key to decrypting messages before allowing rendering of the content (column 11 lines 36-53 and column 12 lines 15-23 and column 18 lines 20-33 and Fig. 3) Barlow does not specifically teach the physical key decrypts the activation key before the activation key allows rendering of the video content. It would have been obvious to one of ordinary skill in the art to allow the physical key in Barlow's' teaching to decrypt the activation key for preventing authorized access of the content.

As to claim 51, Barlow teaches a session key stored in the security separable module that allows rendering of the video content (column 11 lines 36-65).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lee (U. S. Patent 6,003,100) discloses user-removable central processing unit card for an electronic device.

Mizrahi (US 2001/0037303 A1) discloses selectively recording content relating to an audio/visual presentation.

Piotrowski et al. (US 2002/0140871 A1) discloses seamless control of input TV signals.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final
Communications labeled "BOX AF")
(571) 273-6705 (Draft Communications)

Mary Cheung
Primary Examiner
Art Unit 3621
March 20, 2006



MARY D. CHEUNG
PRIMARY EXAMINER